amendments to the claims made, hereby, and subsequent remarks.

Claims were rejected under 35 USC 112, first paragraph, and 35 USC 112, second paragraph. Reconsideration is respectfully requested.

The reason for rejection found in paragraph 7 of the final office action objected to the word "interacts," as applied to the relationship between the recited "probe" and "nucleic acid." By the present amendment, the claims now read "at least one probe which interacts **by hybridizing or intercalating** with the nucleic acid to be detected." According to the statement of rejection, "interacts" was considered objectionable as not indicating whether "the probe intercalates with or hybridizes to the amplified nucleic acid." By the present amendment, either "hybridizing or intercalating" is the means by which the probe interacts with the nucleic acid; as explained in the present specification at, for example, page 7, first paragraph, and page 15, last paragraph (particularly, line 9 of the last paragraph).

The reason for rejection found in paragraph 8 of the final office action was withdrawn pursuant to the Advisory Action.

The reason for rejection found in paragraph 9 of the final office action is considered overcome by inserting the word --detected-- in claim 76; such that the claim reads "nucleic acid to be detected."

The reason for rejection found in paragraph 10 of the final office action was withdrawn pursuant to the Advisory Action.

The reason for rejection found in paragraph 11 of the final office action concerns the language appearing in claim 72 that reads "the sequence of which is homologous

to a sequence to be analyzed, with the exception of **at least one point mutation" [emphasis added]**. According to the examiner, the specification, as originally filed, lacks support for the limitation of "at least one point mutation"; specifically, the statement of rejection maintaining that support exists only for a point mutation occurring "in a sequence region of lowest stability." Applicants respectfully submit that the allegation contained in these statements of rejection is mistaken with respect to the support found in the originally filed specification.

Specifically, support for the language "at least one point mutation" is found, expressly in original claim 6. The relevant part of original claim 6 reads as follows:

> The sequence of which is homologous to a sequence to be determined, preferably identical, with the exception of at least one point mutation which, **preferably**, lies in a sequence region of lowest stability [emphasis added.]

The operative word found in the relevant part of original claim 6 is "**preferably.**" That is, original claim 6 describes the sequence to be determined as homologous "with the exception of at least one point mutation"; with the point mutation occurring "in a sequence region of lowest stability" being a **preferable** embodiment.

The claims of an application as originally filed form part of the original disclosure of the specification; a rejection under Section 112 for lack of descriptive support being improper where the language at issue is found in the original claims. In re Koller, 204 USPQ 702 (See CPA 1980). "If a specification provides a statutory description via a generic expression which is understandable, the presence of specific examples cannot, in ex parte practice, to be said to limit that expression." 204 USPQ at 706. Therefore, that the claims read on embodiments where the point mutation occurs other than at a

sequence of lowest stability does not establish a violation of the requirement of Section 112, first paragraph. Failure to satisfy the requirements of Section 112, first paragraph, is not established by mere allegations of breadth; that is, by alleging that claim language reads on non-disclosed embodiments. Horton v. Stevens, 7 USPQ 2nd 1245 (BPA & I 1988). In other words, claim 72 does not include new matter because it does not recite that the point mutation occurs at a sequence of lowest stability.

Similarly, page 6, first paragraph, of the specification provides adequate support for claim 72; although cited in the statement of rejection for the opposite reason. Page 6 of the specification reads that the sequence is homologous "with the exception of at least one point mutation **which, in particular,** lies in a sequence region of lowest stability." [emphasis added]. Again, occurrence in the sequence region of lowest stability is described as a "particular" embodiment; not as a required aspect of the presently claimed invention.

The reason set forth in paragraph 12 of the final office action is overcome by the present amendment; whereby claim 75 now reads that the analysis is determined within the --free solution--, instead of within the "homogenous phase."

The reason for rejection found in paragraph 13 of the final office action is rendered moot by canceling the language considered objectionable. That is, the language "excitation-effect emitting of electromagnetic radiation" has been deleted from the claims.

The reason for rejection found in paragraph 14 of the final office action, the last reason for rejection, is also rendered moot by canceling the language considered

objectionable. That is, the language "non-naturally occurring" has been cancelled from the claims.

Favorable action commensurate with foregoing is requested.

Respectfully submitted,

By: _____
William E. Player
Reg. No. 31,409

JACOBSON, PRICE, HOLMAN & STERN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004-2201
(202) 638-6666
Atty. Dkt. No.: 10496/P58151NA
Dated: December 30, 1996